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EXAMINER

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ART UNIT PAPER NUMBER

3722

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/853,568
Filing Date: August 03, 2001
Appellant(s): SHOEMAKER, CATHERINE

MAILED
APR 04 2005
GROUP 3700

Jonathan M. Pierce
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 04, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 22-26 stand or fall together with respect to the 35 U.S.C. 112, first paragraph rejections and claims 19-26 stand or fall alone with respect to the 35 U.S.C. 103 rejections and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,435,600 GRIFFITHS et al. 7-1995

<http://www.walgreens.com> (October 02, 2000)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Specification fails to support the restrictive limitation of the second side of the label for marking a prescription medicine having *only* a non-textual, descriptive graphic. While applicant does not specifically show the label having textual, descriptive graphics, applicant fails to limit the indicia on the label to non-textual, descriptive graphic indicia. Therefore, the label is capable of receiving non-textual as well as textual, descriptive graphic indicia.

2. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffiths et al. (5,435,600) in view of www.walgreens.com (Walgreens – “Acid Free Printout”).

Griffiths et al. disclose a device for describing prescription medicine contained in a prescription medicine receptacle (40) comprising a label (10) that is capable of being

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mounted to the receptacle (via adhesive 14 on the bottom surface 13 of the label) having pre-printed indicia (21, 22, 22' – “a line with associated alpha numeric indicia for a doctor’s name, a line and associated alpha numeric indicia for a patient’s name, and a line and associated alpha numeric indicia for a date” see column 4, lines 59-68 through column 5, lines 1-2) and handwritten indicia (“the doctor’s name 42, patient’s name 43, and date 44” see column 5, lines 53-57. Griffiths et al. further disclose providing other indicia on the label (see column 5, lines 57-62; inherently, this would include a label having a picture that alone identifies the prescription medicine). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the label, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of label does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Furthermore, Walgreens.com discloses a device for describing the medicine contained in a medicine receptacle comprising a label having a picture that alone identifies the medicine (Acid Free contains a label having the picture of a user’s

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stomach receiving a chewable tablet that will neutralize the acid in the user's stomach associated with heartburn caused by acidic foods), wherein the label is mounted to a container holding the medicine. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the label of Griffiths et al. to include a picture that alone identifies the prescription medicine in the prescription medicine receptacle, as taught by Walgreens, to provide the user with a method for easily identifying the medicine in the receptacle at a glance.

Regarding claims 20 and 23-26, Griffiths et al., as modified by Walgreens, disclose the picture on the label of the prescription medicine container depicting why the medicine is being used/taken, the symptoms/aliments which the medicine treats and the results of consumption of the medicine (e.g., to neutralize the acid in the user's stomach associated with heartburn caused by acidic foods as seen in Walgreens.com).

Regarding claim 21, Griffiths et al., as modified by Walgreens, disclose the picture on the label of the prescription medicine container depicting the body part for which the medicine is being used (e.g., stomach as seen in Walgreens.com).

Regarding claim 22, Griffiths et al., as modified by Walgreens, disclose a first side (13- bottom surface of Griffith et al.) having an adhering surface (14 – pressure sensitive adhesive of Griffith et al.) capable of adhering to the prescription medicine container (40); and a second side (12 – top surface of Griffith et al.) having indicia for conveying the type of prescription medicine within the prescription medical container (pre-printed indicia 21, 22, 22' – “a line with associated alpha numeric indicia for a doctor's name, a line and associated alpha numeric indicia for a patient's name, and a

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line and associated alpha numeric indicia for a date” (see column 4, lines 59-68 through column 5, lines 1-2 and handwritten indicia “the doctor’s name 42, patient’s name 43, and date 44” see column 5, lines 53-57). Griffiths et al. further disclose providing other indicia on the label (see column 5, lines 57-62; inherently, this would include a label having a non-textual, descriptive graphic that conveys the type of prescription medicine within the prescription medical container).

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of label does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Furthermore, Walgreens.com discloses a device for describing the medicine contained in a medicine receptacle comprising a label having a picture that alone identifies the medicine (Acid Free contains a label having the picture of a user’s stomach receiving a chewable tablet that will neutralize the acid in the user’s stomach associated with heartburn caused by acidic foods), wherein the label is mounted to a container holding the medicine. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the label of Griffiths et al. to

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include a non-textual, descriptive graphic that conveys the type of prescription medicine in the prescription medical container, as taught by Walgreens, to provide the user with a method for easily identifying the prescription medicine in the container at a glance.

Note: the limitation of the second side having only a non-textual, descriptive graphic has not been fully supported in the specification as set forth in the above 35 U.S.C. 112, 1st paragraph rejections.

(11) Response to Argument

A. Rejection of Claims 22-26 under 35 U.S.C. 112, first paragraph

Appellant argued that she has unquestionably conveyed to those of ordinary skill in the art, as of the filing date, that she was in possession of a label having only a non-textual descriptive graphic. Appellant submitted citations from the specification to support her position.

The examiner disagrees with appellant and asserts that while appellant has disclosed the label having non-textual descriptive graphic, appellant also discloses, in figure 3, textual descriptive graphics which support the examiner's position that appellant has failed to disclose providing *only* non-textual descriptive graphics on the label.

In figure 3 of appellant's application, the preferred embodiment discloses the label 30 including a non-textual graphic of a person's head and neck and a textual

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graphic (Z's). The combination of the non-textual and textual graphics is used to describe the medication contained in the prescription medicine receptacle. If the non-textual graphic were depicted without providing the textual graphic of the Z's, one may not readily ascertain what was actually contained in the prescription medicine. It could, for example, indicate a prescription medication for a person having a problem with hair loss and by taking this prescription medication, the person would regain their hair.

Therefore, according to appellant's figure 3, non-textual as well as textual descriptive graphics are used to describe the medication contained in the prescription medicine receptacle. The examiner maintains, therefore, that support for the restrictive limitation of having *only* non-textual descriptive graphics has not been supported by the specification and drawings as asserted by appellant. The examiner maintains that the rejections of Claims 22-26 under 35 U.S.C. 112, first paragraph are proper.

B. Rejections of Claims 19-26 Under 35 U.S.C. 103(a)

1. Rejection Based on Griffiths

The appellant argues that Griffiths does not disclose or suggest the indicia on the label being a picture that alone identifies the prescription medicine, a picture depicting why the medicine is being used, a picture depicting a body part, a non-textual, descriptive graphic conveying the type of prescription medicine within the prescription medicine container, a graphic depicting the ailment or a graphic depicting the results of consumption. Appellant argues that Griffiths

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indicia is general and could not inherently include indicia having the pictures or non-textual graphics as recited in claims 19-26.

The examiner asserts that while Griffiths does not explicitly disclose the claimed printed matter on the label, Griffiths, as modified by the Acid-Free Printout, does and will be discussed in detail below.

2. Rejection Based on “Printed Matter” Doctrine

Appellant disagrees with the examiner’s conclusion that the printed matter required by the claims of the present application is not functionally related to the substrate. The appellant refers to *In re Miller*, 164 USPQ 46, to substantiate her position that the printed matter in the present invention is functionally related to the substrate.

The examiner disagrees with appellant’s assertion. In *In re Miller*, the claims were directed toward a measuring cup or receptacle for measuring partial recipes. Measuring indicia on the receptacle indicated a quantity different from the actual quantity measured. The indicia on the substrate was required to be located in a particular position to convey meaningful information in regard to the substrate. In other words, in order to accurately measure a substance to be used in a recipe, the indicia on the receptacle is required to be placed at specific measured locations. In this case, the printed elements of the invention acted in combination with the structure on which they were printed (the “substrate”) to perform a function that was neither anticipated nor made obvious by the prior art.

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In the present invention, the claimed label visually describes prescription medicine contained in a prescription medicine receptacle. In contrast to *In re Miller*, the indicia placed on the label describing the prescription medicine does not act in combination with the structure on which it is printed. Therefore, the indicia on the label merely comprises printed matter which is supported by a substrate where the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner asserts that the label having indicia and capable of being mounted to the receptacle is the same structure claimed by appellant and the sole difference is in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

3. Rejection Based on Griffiths in view of the “Acid-Free Printout”

a) The Examiner has not established that the Acid-Free Printout is Prior Art

Appellant argues that the examiner has failed to provide evidence that the Acid-Free Printout is prior art under 35 U.S.C. 102.

The examiner disagrees. The examiner submitted a copy of the pages from the website used (<http://www.walgreens.com>) in the rejections. The examiner also

submitted a copy of the search engine (<http://www.archive.org>) used to obtain the priority date for the page. The examiner used search engine's website to enter the web address for Walgreens. A search for Acid-Free was done and provided the page used in the rejections. The page disclosed that the Acid-Free medicine container was in public use and for sale as required by 35 U.S.C. 102(b) prior to the filing date of appellant's invention. Furthermore, since the Acid-Free product was available for public use, it was also reduced to practice prior to appellant's filing date. The examiner, therefore, maintains that she has established the Acid-Free Printout as Prior Art.

b) Assuming the Board Concludes that the Acid-Free Printout is Prior Art, the Combination of Griffiths and the Printout do not render the claims obvious

Appellant argues that neither Griffiths nor Acid Free discloses or suggests the indicia being a picture or graphic that alone identifies a prescription medicine. Rather, Griffiths does not use any picture or graphic and the Acid Free Printout uses a picture or graphic in combination with text describing the medicine. Appellant also argues that Acid Free addresses over the counter (OTC) medicine and not prescription medicine labels.

The examiner, again, asserts that support for the restrictive limitation of having *only* non-textual descriptive graphics has not been supported by the specification and drawings as asserted by appellant. In figure 3 of appellant's application, the preferred embodiment discloses the label 30 including a non-textual graphic of a person's head

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and neck and a textual graphic (Z's). The combination of the non-textual and textual graphics is used to describe the medication contained in the prescription medicine receptacle. If the non-textual graphic were depicted without providing the textual graphic of the Z's, one may not readily ascertain what was actually contained in the prescription medicine. It could, for example, indicate a prescription medication for a person having a problem with hair loss and by taking this prescription medication, the person would regain their hair.

In the same manner as appellant's invention discloses non-textual and textual descriptive graphics (in figure 3 of appellant's application, the preferred embodiment discloses the label 30 including a non-textual graphic of a person's head and neck and a textual graphic (Z's). Griffiths, as modified by the Acid Free Printout, discloses using non-textual and textual descriptive graphics to identify the prescription medicine. Griffiths discloses a device for describing prescription medicine contained in a prescription medicine receptacle 40 comprising a label 10 capable of being mounted to the receptacle (via adhesive 14 on the bottom surface 13 of the label) having pre-printed indicia and handwritten indicia. The Acid Free Printout teaches providing a medicine receptacle with a label mounted thereon and having a picture that alone identifies the prescription medicine. The picture is of a user's stomach receiving a chewable tablet that will neutralize the acid in the user's stomach associated with heartburn caused by acidic foods. It is noted that the examiner has not relied upon the Acid Free Printout for disclosing a prescription medication receptacle. However, it is well known in the pharmaceutical industry for medicine to be available as a prescription one

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year and then as an over-the-counter medication the next and vice versa as necessitated by the industry and the United States Food and Drug Administration (FDA).


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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March 29, 2005

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